



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,182	06/15/2001	Jean-Paul Vidot	CELA:082	6962

7590 07/23/2003

Parkhurst & Wendel
Suite 210
1421 Prince Street
Alexandria, VA 22314-2805

EXAMINER

LUONG, VINH

ART UNIT	PAPER NUMBER
----------	--------------

3682

11

DATE MAILED: 07/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/868,182

Applicant(s)
VIDOT et al.

Examiner
Luong

Art Unit
3682



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/14/03
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above, claim(s) 4 and 12-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-11, and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/15/01 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 5/14/03 is: a) ☐ approved b) ☒ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input checked="" type="checkbox"/> Other: <u>Exhibits I & II</u> |

Vinh T. Luong
Primary Examiner

Art Unit: 3682

1. The Amendment filed on May 14, 2003 (Paper No. 10) has been entered.
2. Claims 4 and 12-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

Claims 3 and 5 are examined with claims 6-11 because claim 6 is dependent upon claim 5 which in turn is dependent upon claim 3.

3. This application contains claims 4 and 12-28 are drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.
4. The abstract of the disclosure is objected to because the abstract should not: (a) be underlined; and (b) use the legal phraseology "means." Correction is required. See MPEP § 608.01(b).
5. The listing of references (DE 195 15 852 A1) in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.
6. The information disclosure statement filed on May 14, 2003 which is incorporated into the Remarks on page 25 of Paper No. 10 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because of the reasons, e.g., listed below:

Art Unit: 3682

(a) the copy of DE 195 15 852 A1 was submitted after the First Office Action but it lacked a statement as specified in 37 CFR 1.97(e) or the fee set forth in 37 CFR 1.17(p); and

(b) DE 195 15 852 A1 was not listed in a separate paper. See MPEP § 609 A(1).

The copy of DE 195 15 852 A1 has been placed in the application file, but the information referred to therein has not been considered as to the merits. *Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 C(1).*

7. The proposed drawing corrections and/or the proposed substitute sheets of drawings filed on May 14, 2003 have been disapproved because:

(a) the corrections are not in the form of a pen-and-ink sketch showing changes in red ink or with the changes otherwise highlighted. See MPEP § 608.02(v);

(b) they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of, e.g., the following elements in new Fig. 9: (1) the curved or concave profile 19a; (2) the unnumbered second rib as seen in Exhibit I attached. The original Fig. 2 shows only one rib 33, thus, the introduction of the second rib is new matter; and (3) the curved profile of the chamber 27;

Art Unit: 3682

(c) the sectional plane, such as, I-I in Fig. 2 should have been changed to III-III in order to correspond to Fig. 3; and

(d) they are not embodied in a separate letter as required in MPEP 608.02(r).

8. The *original* drawings are objected to because:

(a) the sectional plane, such as, "A-A" in Fig. 2 should have been changed to "III-III" in order to correspond to Fig. 3; and

(b) each part of the invention, such as, the groove located in the surface of the axial bore 20 in claim 10 should be designated by a referential numeral or character.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

9. The *original* drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, (a) the external profile 18 which is disengaged from the matching profile 19 of the matching second surface in claim 7; and (b) the groove located in the surface of the axial bore 20 in claim 10 must be shown or the features canceled from the claims. *No new matter should be entered.*

The original Fig. 2 shows that the profiles 18 and 19 form a straight line, thus, they are not disengaged from each other. The moved or alternate positions, such as, the engaged and disengaged positions of the profiles 18 and 19 are required to be shown in accordance with 37 CFR 1.84(h)(4).

Art Unit: 3682

In addition, the original Fig. 2 shows the groove 31, however, the groove 31 is not arranged on the cylindrical surface of the internal bore 20.

10. The amendment filed May 14, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is, *e.g.*, as follows: the description of new Fig. 9 in the specification on page 7, lines 11-34; page 8, lines 5-6 and lines 10-15. For example, the new elements in new Fig. 9 as shown in Exhibit attached are unsupported by original disclosure. Applicant is required to cancel the new matter in the reply to this Office Action.

11. The disclosure is objected to because of the following informalities: the sectional plane, such as, "I-I" in Fig. 2 should have been changed to "III-III" in order to correspond to Fig. 3. Appropriate correction is required.

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 1-3, 5-11, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether a confusing variety of terms, such as, "two mechanical elements" and "first and second mechanical elements" in claim 1 refers to the same or different things. See MPEP 608.01(o) and 2173.05(o).

Art Unit: 3682

14. Claims 1, 2, and 29, as best understood, are rejected under 35 U.S.C. 102(a) as being anticipated by Camp'372 (DE 196 17 372 C1 cited in applicant's corresponding PCT application).

Regarding claim 1, Camp'372 teaches a pyrotechnically unlockable mechanical linking device 30 between two mechanical elements 26 and 18 (Fig. 1) for receiving tensile and/or compressive forces along a first axis 24 (Fig. 2), said device comprising:

first and second mechanical elements 26 and 18;

at least one pyrotechnic component 50;

retention means 44 *capable of* being released by pressure of gases generated by igniting the pyrotechnic component 50; and

at least one locking means 32, 40 having an axial bore 32 and linking together the two mechanical elements 26 and 18 by applying a linking force along at least a second axis (unnumbered, see Exhibit II attached), said locking means 32, 40 *capable of* being released when the mechanical elements 26 and 18 are subjected to tensile and/or compressive forces along said first axis 24 and held in a locking position by said retention means 44, wherein

the retention means 44 comprise a piston 44 having a first *external* surface (see Exhibit II) and *capable of* sliding in said axial bore 32 in response to gas pressure generated by the pyrotechnic component 50, the locking means 32, 40 being in contact with the first external surface of the piston 44, which ensures retention of the locking means 32, 40 in the locking position.

Claim 1 and other claims below are anticipated by Camp'372 since Camp'372 teaches each and every positive claimed element. See *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781, 789

Art Unit: 3682

(CAFC 1983). It has long been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138 (CCPA 1946). In addition, it is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 2, the locking means 32, 40 are linked with said first mechanical element 26 and comprise at least one first surface 48 (Fig. 2) having a profile 48 for cooperating with a second surface (unnumbered at an outer end of the piston 44 and abutted with the first surface 48 as seen in Exhibit) having a matching profile *integral* with said first mechanical element 26, the locking means 32, 40 also delimits at least partially the axial bore 32 for slidably receiving the piston 44. Note that the term “integral” is not restricted to a one-piece article. The term “integral” is sufficiently broad to embrace constructions united by such means as fastening and welding. See *In re Hotte*, 177 USPQ 326 (CCPA); *In re Clark*, 102 USPQ 241 (CCPA); *In re Dike*, 157 USPQ 581 (CCPA); *In re Kohno*, 157 USPQ 275 (CCPA); and *In re Morris*, 43 USPQ2d 1753, 1757 (CAFC 1997).

Regarding claim 29, Camp’372’s first mechanical element 26 is integral with one end of a rod 26 of a master brake cylinder for a vehicle and the second mechanical element 18 is integral with a brake pedal 18.

Art Unit: 3682

15. Claims 3 and 5-11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

16. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

17. Applicant's arguments filed May 14, 2003 have been fully considered but they are not persuasive.

The examiner responds to applicant's remarks in the numerical order used by applicant:

1.

The substitute abstract is objected to as seen above.

2. & 3.

The drawing corrections and new Fig. 9 have been disapproved as seen above.

4.

The amended specification introduces new matter as seen above.

5.

The rejection under 35 USC 112, first paragraph, has been withdrawn in view of applicant's remarks.

6.

Art Unit: 3682

The previous rejection under 35 USC 112, second paragraph, is withdrawn in view of applicant's amendment. However, applicant's claims are still indefinite due to double inclusion by using the terms "two mechanical elements" and "first and second mechanical elements" in claim 1.

7.

At the outset, applicant contends that the examiner's characterization of the element 44 of Camp'372 as being the retention means 44 does not comprise "piston 38." The examiner agrees with the instant contention. Therefore, in this final rejection, the retention means 44 is interpreted as the piston 44.

Applicant further alleges that Camp'372's locking means 40 contacts the internal surface of piston 44, not its external surface, as recited by applicant's claim 1.

Applicant is respectfully noted that, during patent examination, claims are given their broadest reasonable interpretation consistent with the specification. It is proper to use the specification to interpret what the applicant meant by a word or phrase recited in the claim. However, it is not proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); and *Intervet America Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989).

The examiner respectfully submits that applicant apparently used an "*ipsissimis verbis*" test that requires the same terminology in the prior art in order to find anticipation. See footnote 11 in *AKZO N.V. v. International Trade Commission*, 1 USPQ2d 1241, 1245 (CAFC 1986). In the instant

Art Unit: 3682

case, Camp'372 does not need to use applicant's own lexicography such as "locking means" to anticipate applicant's claims. It is well settled that anticipation law requires distinction be made between invention described or taught and invention claimed. It does not require that the reference "teach" what subject patent application teaches, it is only necessary that the claim under attack, as construed by the Court, "*read on*" something disclosed in the reference, *i.e.*, all limitations of the claim are found in reference, or are "*fully met*" by it. *Kalman v. Kimberly Clark Corp.*, *supra*.

Returning to the case at hand, Camp'372's piston 44 is slid back and forth in the bore 32. In addition, Camp'372's wall surface 48 acts as a stop to delimit the travel of the piston 44 as transparently shown in Fig. 2. Therefore, the elements 32 and 40 of Camp'372 perform as the locking means to release or lock (stop) the travel of the piston 44. More important, Fig. 2 plainly shows that the external surface of piston 44 contacts the internal surface, *i.e.*, the bore of the sleeve 32 as claimed, *a fortiori*, applicant's claim 1 is "fully met" by Camp'372.

For the reasons stated above, the rejection under 35 USC 102(a) is maintained.

18. Applicant's arguments with respect to claims 1-3, 5-11, and 29 have been considered but are moot in view of the new ground(s) of rejection.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the

Art Unit: 3682

mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 8:30 AM EST to 7:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. The fax phone number for this Group is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong

July 21, 2003



Vinh T. Luong
Primary Examiner